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| DIGEO, INC. 8815 122ND NE KIRKLAND, WA 98033 | | | SRIVASTAVA, VIVEK | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,558

Applicant(s)

YAMAMOTO, HENRY H.

Examiner

Vivek Srivastava

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-20, 22-27, 29, 30 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-20, 22-27, 29, 30 and 37-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant argues the prior art fails to disclose the amended “providing a notification to a user of an expiration date of a coupon separate from the expiration date printed on the coupon.”

The Examiner concurs. However this amended limitation would have been well known. See rejection below.

Applicant argues the office has also failed to show, and applicant is unable to find, where any of the cited and applied references, either alone or in combination, disclose “respond to a request received from a user in response to the information presented and allow the user to redeem the coupon on a channel different from the second channel” as recited in claim 17.

The Examiner agrees with Applicant that the applied references fails to show allowing a user to redeem the coupon on a channel different from the second channel. However, it would have been obvious to modify Jones to include this feature as discussed below.

Applicant argues the Office has further failed to show, and applicant is unable to find, where any of the cited and applied references, either alone or in combination,

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disclose "correlating information related to a television program on a first channel with information related to a coupon on a second channel, the information related to the coupon on the second channel including information related to user" as recited in claim 26. Applicant further argues it is true that demographic information is discussed by Jones et al at this cited portion but the demographic information pertains to a group of people. In contrast, the claimed limitation requires "information related to a user".

The Examiner respectfully disagrees. Jones discloses, in regards to the demographic information, "*The information may include whether the site is a home or business, the number of persons at the site, their ages and sexes, their consumption habits and the classes of products in which they would likely be interested.*" This information (emphasis added) is directly related the user as the demographic information is based on the user's age, sex, consumption habit and products interested in. As a result, the Applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26, 27, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al (US 5,978,013).

Regarding claim 26, Jones discloses an apparatus, article of manufacture and method for generating product coupons in response to televised offers. Jones discloses advertising programming may offer a coupon for the product advertised (see col 4 lines 60 – 65) by embedding a coupon identifier in a television video signal (see col 4 lines 60 – 65). Jones still further discloses that transmitted advertising program may be broadcast by standard television (see col 12 lines 54 – 57) which inherently includes a 'first channel of an interactive video casting system. It is noted that the user can input a request on a remote control for the coupon (see col lines 25 – 47) providing for an interactive system.

Jones further discloses transmitting a coupon or token identifier in the blanked line and hence the same channel as the product advertisement (see col 21 lines 63 – 67) to retrieve coupon information on a second distinct data channel (see col 3 lines 1 – 9). It is noted that the token identifier comprises a code which links or correlates the token identifier of the advertisement displayed on the first channel to a coupon received on the second data channel (see col 2 line 63 – col 3 line 9, col 5 lines 8 – 29, col 9 lines 30 – 48). It is noted that Jones discloses "This token information is either transmitted to the viewer's site or pre-stored in a memory at the user's site" (see col 3 lines 1 – 8).

Jones discloses a user can request or 'command' retrieval of the coupon, based on the coupon or token identification code, by inputting a command on a remote control (see col 9 lines 21 – 29), which provides retrieval of the coupon on the second or data

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channel to allow printing or utilization of the coupon thus enabling a user to initiate a transaction related to the coupon on the second channel (see col 10 lines 16 – 30).

It is further noted, with regards to claim 26, since the coupon or token identifier is linked or correlated with at the appropriate coupon, the coupon or token identifier on the first channel is consistent with the coupon on the second channel.

Jones further discloses, in regards to the demographic information, “*The information may include whether the site is a home or business, the number of persons at the site, their ages and sexes, their consumption habits and the classes of products in which they would likely be interested*” (see col. 9 lines 10 – 15). Thus Jones discloses the claimed “..the information related to the coupon on the second channel including information related to the user.”

Regarding claim 27, Jones discloses the claimed coupon includes merchant information (see col 11 lines 58 – 63).

Regarding claim 29, It is noted that since the coupon is sent to the requesting user, Jones inherently discloses the claimed “wherein the information related to the user is obtained by obtaining a set top box identifier.”

Regarding claim 30, Jones discloses a printing device for printing and redeeming the coupon (see col 10 lines 16 – 30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 6, 9 – 14, 25 and 37 – 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 5,978,013) .

Regarding claim 1, Jones discloses an apparatus, article of manufacture and method for generating product coupons in response to televised offers. Jones discloses advertising programming may offer a coupon for the product advertised (see col 4 lines 60 – 65) by embedding a coupon identifier in a television video signal (see col 4 lines 60 – 65). Jones still further discloses that transmitted advertising program may be broadcast by standard television (see col 12 lines 54 – 57) which inherently includes a 'first channel of an interactive video casting system. It is noted that the user can input a request on a remote control for the coupon (see col lines 25 – 47) providing for an interactive system.

Jones further discloses transmitting a coupon or token identifier in the blanked line and hence the same channel as the product advertisement (see col 2 lines 63 – 67) to retrieve coupon information on a second distinct data channel (see col 3 lines 1 – 9). It is noted that the token identifier comprises a code which links or correlates the token identifier of the advertisement displayed on the first channel to a coupon received on the second data channel (see col 2 line 63 – col 3 line 9, col 5 lines 8 – 29, col 9 lines 30 –

48). It is noted that Jones discloses “This token information is either transmitted to the viewer’s site or pre-stored in a memory at the user’s site” (see col 3 lines 1 – 8).

Jones discloses a user can request or ‘command’ retrieval of the coupon, based on the coupon or token identification code, by inputting a command on a remote control (see col 9 lines 21 – 29), which provides retrieval of the coupon on the second or data channel to allow printing or utilization of the coupon thus enabling a user to initiate a transaction related to the coupon on the second channel (see col 10 lines 16 – 30).

Jones fails to disclose the claimed “providing a notification to a user of an expiration date of a coupon separate from the expiration date printed on the coupon.”

Official Notice is taken it would have been well known to provide a user with an electronic notification of the expiration of a coupon (separate from any notification printed on the coupon) for the benefit of alerting or notifying a user as to how long the coupon is valid. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include the claimed “providing a notification to a user of an expiration date of a coupon separate from the expiration date printed on the coupon” for the benefit of alerting or notifying the user as to how long the coupon is valid.

Regarding claim 2, Jones discloses the interactive system is a television system (see col 4 lines 33 – 39).

Regarding claim 3, Jones discloses triggers which provide a visual display of “COUPON AVAILABLE” or an “announcement” (see col 5 lines 1 – 8).

Regarding claim 4, Jones fails to disclose the claimed wherein linking the first channel to the second channel over at least a portion of the television program, generating a picture-in-picture arrangement to concurrently present the content on the second channel with the television program on the first channel, or tuning from the first channel to the second channel to replace presentation of the television program with presentation of the content.

Official notice is taken it would have well known to overlay supplemental content on program content to enable a user to view both content simultaneously. Therefore, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify Jones to include the claimed limitation to enable a user to simultaneously view the commercial advertisement with the coupon.

Regarding claims 5 – 6, Jones discloses demographic information or user-related data which includes ages, consumption habits etc. which is utilized with respect to linking and retrieving coupons (see col 9 lines 4 – 19).

Regarding claim 9, Jones discloses providing coupons on a separate different channel and thus suggests that transmitting of information need not be limited to one channel. It would have been obvious to modify Jones to include sending the coupon notification on a coupon on a channel different from the second channel. Therefore, it would have been obvious to modify Jones to include the claimed limitation for the benefit of providing a user with coupon expiration information on a data channel which is separate from the program channel and thus maximizing bandwidth efficiency by balancing the transmission of data on a variety of channels.

Regarding claim 10, Jones discloses retrieving and printing the appropriate coupon based on a code and thus discloses the claimed ‘wherein the transaction related to the coupon includes searching for one or more coupons’ (see col 9 lines 30 – 67, col 10 lines 16 – 30).

Regarding claim 11, Jones discloses an image memory for storing the coupon before printing (see col 10 lines 16 – 30).

Regarding claim 12, Jones discloses sorting the plurality of coupons in an order for a viewer to select (see col 10 lines 50 – 67).

Regarding claim 13, Jones discloses a printing device for printing and redeeming the coupon (see col 10 lines 16 – 30).

Regarding claim 14, Jones discloses the claimed smart card (see col 2 lines 58 - 63).

Regarding claim 25, Jones fails to disclose the claimed wherein the machine-readable medium further includes instructions stored thereon to allow the user to send a coupon to an email address.

Official Notice is taken it is well known for a user to send information to an email address to enable forwarding of information to a destination of user's choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include the claimed limitation to enable a user to send the coupon to a choice destination.

Regarding claims 37 and 41, Jones discloses an apparatus, article of manufacture and method for generating product coupons in response to televised

offers. Jones discloses advertising programming may offer a coupon for the product advertised (see col 4 lines 60 – 65) by embedding a coupon identifier in a television video signal (see col 4 lines 60 – 65). Jones still further discloses that transmitted advertising program may be broadcast by standard television (see col 12 lines 54 – 57) which inherently includes a 'first channel' of an interactive video casting system. It is noted that the user can input a request on a remote control for the coupon (see col lines 25 – 47) providing for an interactive system. Jones further discloses that the commercial can be stored and retrieved from one or more optical disk sources to provide coupons for the coupon channel (see col 6 lines 43 – 63). It is noted that more than one optical disks constitute a plurality of sources. Jones further discloses the coupon is affiliated with one advertiser or merchant which is in communication with the interactive video casting system (see col 11 lines 58 – 65). Jones discloses the offering the coupon includes providing a plurality of features related to transactions that can be conducted with any of the coupons available from the coupon channel including storage of the coupon printing of the coupon, a discount amount utilized in coupon transactions and a UPC bar-code utilized in coupon transactions.

Jones discloses a user can request or 'command' retrieval of the coupon, based on the coupon or token identification code, by inputting a command on a remote control (see col 9 lines 21 – 29), which provides retrieval of the coupon on the second or data channel to allow printing or utilization of the coupon thus enabling a user to initiate a transaction related to the coupon on the second channel (see col 10 lines 16 – 30).

It is noted that the transaction of printing is subsequent to the correlation of the received command with offered coupon.

Jones fails to disclose providing an electronic notification related to the offered coupon from the interactive video casting system subsequent to conducting the transaction, the electronic notification capable of being provided to the client terminal for display on the display screen.

Official Notice is taken it would have been notoriously well known to provide an electronic notification after a transaction of transferring data to notify and to ensure a receiver is aware that data has been transmitted. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include providing a electronic notification related to the offered coupon subsequent to the conducting the transaction to ensure the receiver is notified that the coupon has been sent and should have been received.

As discussed above, Jones discloses providing a coupon via a separate data channel, but fails to disclose the claimed electronic notification further capable of being provided on one of the channels of the interactive video casting system that is different from the coupon channel.

Based on the suggestion of Jones to transmit coupons on a separate data channel, it would have been obvious to further modify Jones to transmit the electronic notification discussed above on the separate data channel to maximize bandwidth and system efficiency by placing all the supplemental data on one channel. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention

was made to modify Jones to include the claimed limitation to maximize bandwidth and system efficiency.

Claim 38 is met by the above discussions.

Regarding claims 39 and 42, Jones discloses wherein offering the coupon comprises offering the coupon during a television program that is presented on a channel different from the coupon channel (see col 2 line 63 – col 3 line 8).

Regarding claims 40 and 43, Jones fails to disclose the claimed wherein notification is capable of being provided to a device different from the client terminal.

Jones suggests the user of sending information to a smart card (as discussed above). Official notice is taken It would have been well known to send notification information to another portable device like a remote control, PDA, or pager etc. Therefore, it would have been obvious to modify Jones to include the claimed limitations for the benefit of providing a notification to a portable handheld device which is easily accessible by a user.

Regarding claim 44, Jones discloses printing the coupons (see col 10 lines 16 – 30).

Claims 8 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Wehmeyer (US 6,169,543).

Regarding claim 8, Jones fails to disclose the claimed obtaining from the user a preference for a date to be notified of the expiration data of the coupon.

In analogous art, Wehmeyer teaches a system and method wherein a user can input preference information as to what date and time to be automatically notified and reminded about important information (see fig 5A). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include the claimed limitation for the benefit of being notified as to the expiration date of the coupon at a time preference of the user.

Claim 22 is met by the above discussions.

Claims 15 – 17, 20, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 5,978,013) in view of Fortenberry et al (US 6,336,098).

Regarding claims 15 and 16, Jones fails to disclose wherein the transaction related to the coupon includes redeeming the coupon and wherein redeeming the coupon includes redeeming the coupon on a merchant web site.

Official Notice is taken it would have been notoriously well known in the art the use of PCTV or web TV with a virtual channel would provide a viewer with a access to wide variety of programming and resources which would include e-shopping or shopping on the Internet. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the existing TV in Jones to a PCTV or web TV with a virtual channel to provide a user with access to a wide variety of resources thereby enhancing a user's viewing experience.

In analogous art, Fortenberry et al teaches a method for electronic distribution and redemption of coupons on the world wide web (see Abstract). Fortenberry further teaches *"With the growth of the Internet, e-commerce and secure transactions, more consumers are purchasing items over the Internet"* (see col. 1 lines 51 – 55). It would have been obvious to modify Jones to include allowing a user to redeem the coupon on a virtual channel (a separate channel) coupled to the Internet and merchant web site for the benefit of providing a user with discounts which are redeemable over a widely accessible network offering secure transactions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include the claimed "redeeming the coupon and wherein redeeming the coupon includes redeeming the coupon on a merchant web site" for the benefit of enabling a user to redeem coupons from home over a secure, widely accessible network.

Regarding claim 17, the claim limitations common to the claims above have been addressed and are not being re-iterated below. Claim 17 further recites "allow the user to redeem the coupon on a channel different from the second channel" which is not disclosed by Jones.

Official Notice is taken it would have been notoriously well known in the art the use of PCTV or web TV with a virtual channel would provide a viewer with a access to wide variety of programming and resources which would include e-shopping or shopping on the Internet. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the existing TV in Jones to a

PCTV or web TV with a virtual channel to provide a user with access to a wide variety of resources thereby enhancing a user's viewing experience.

In analogous art, Fortenberry et al teaches a method for electronic distribution and redemption of coupons on the world wide web (see Abstract). Fortenberry further teaches "With the growth of the Internet, e-commerce and secure transactions, more consumers are purchasing items over the Internet. It would have been obvious to modify Jones to include allowing a user to redeem the coupon on a virtual channel (a separate channel) coupled to the Internet for the benefit of providing a user with discounts which are redeemable over a widely accessible network offering secure transactions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include the claimed "allowing a user to redeem the coupon on a channel different from the second channel" for the benefit of enabling a user to redeem coupons from home over a secure, widely accessible network.

Regarding claims 18 – 19, Jones discloses correlating by automatically entering and comparing demographic information which is related to the user which identifies the user terminal (see col 9 lines 4 – 13).

Regarding claim 20, Jones discloses integrating coupon ID information relating to coupons and coupon channel in the television commercial channel sent from the interactive video casting system to the client terminal (see col 4 line 60 – col 5 line 27).

Regarding claim 23, Jones discloses transmitting coupons onto a smart card (see col 2 lines 59 – 62) as the claimed 'instructions' are inherent as necessary to perform the claimed functions.

Regarding claim 24, Jones discloses integrating coupon ID information relating to coupons and coupon channel in the television commercial channel sent from the interactive video casting system to the client terminal (see col 4 line 60 – col 5 line 27) as the claimed 'instructions' are necessary to perform the claimed functions.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Darby et al (US 2003/0126597) – Advertisements with internet usage

O'Donnell et al (US 2005/0097594) – Awarding points based on remote usage

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (571) 272-7304. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272 – 7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vs 7/25/05



VIVEK SRIVASTAVA
PRIMARY EXAMINER